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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,556	03/28/2001	Yasuyuki Fujikawa	1614.1158	9443
21171	7590	10/13/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			HUYNH, THU V	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/818,556		FUJIKAWA, YASUYUKI	
	Examiner		Art Unit	
	Thu V. Huynh		2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/21/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed on 07/20/06 to application filed on 03/28/2001 which has foreign priority filed on 10/31/2000.
2. Claims 1, 6 and 9 are amended.
3. Claims 1-13 are pending in the case. Claims 1, 6 and 9 are independent claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-3, 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Chadha, US 6,061,698, patented 05/2000.**

Regarding independent claim 1, Chadha teaches a recording medium readable by a computer, tangibly embodying a program executable by the computer to make a modified

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document based on an original file (Chadha, abstract, col.1, line 51 – col.2 line 6; col.4; lines 16-45; and col.7, lines 24-28; a computer readable program used to make a modified document (linked document 50) based on an original document (markup 38), wherein said original document is stored in a memory device (visual tool 10), and consists plurality areas, wherein a comment areas being provided with special tag identifiers), by:

- reading an original document form the original document file (Chadha, col.5, lines 28-29; reading document 30);
- referring to a parameter which specifies an area to be processed, a word line to be replaced in the area, a word line to be substituted for the replaced word line, to determined the area to be processed in the read original document (Chadha, col.5, line 60 – col.6, line 5; referring a parameter which specifies an area to be processed, such as the area between begin datatag and end datatag, a word line to be replaced in the are, such as source-string “XXX”, and a target-string “%exec_sql(sql1)” for substituting the source-string);
- determining whether the word line specified by the parameter to be replaced is in the area, in response to determining the area to be processed (Chadha, col.5, line 60 – col.6, line 14; determining “XXX” source-string in side the begin datatag and end datatag);
- substituting the word line specified by the parameter for the word line to be replaced in the area in response to determining that the word line to be replaced is in the area to be processed (Chadha, col.6, lines 12-14; col.6, line 50 – col.7, line 5; substituting the target-string “%exec_sql(sql1)” for source-string “XXX”).

Regarding claim 2, which is dependent on claim 1, Chadha teaches wherein said original document is in a fixed format including at least comment, and identification is included in the area to be processed as the comment (Chadha, col.4, line 39 – col.5, line 39).

Regarding claim 3, which is dependent on claim 2, Chadha teaches the limitations of claim 1 as explained above. Chadha teaches wherein said fixed format is an HTML (Hypertext Markup Language) (Chadha, col.1, line 65 – col.2, line 6 and col.4, line 54-64).

Regarding independent claim 6, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

Regarding dependent claim 7, the claim incorporates substantially similar subject matter as claim 2, and is rejected along the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 4 is rejected under 35 U.S. C. 103(a) as being unpatentable over Chadha as applied to claim 1 above and further in view of Conley, US 5,293,629, filed 11/1990.

Regarding claim 4, which is dependent on claim 1, Chadha does not explicitly disclose wherein the area to be processed includes another area by taking a nesting structure.

Conley teaches comment includes nested comments (Conley, col.13, lines 8-10).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined to Hobb's teaching and Chadha's teaching to include nested comments, since the combination would have provided different comment types.

8. Claims 9-12 are rejected under 35 U.S. C. 103(a) as being unpatentable over Chadha as applied to claim 1 above and further in view of Popp et al., US 2002/0133637 A1, filed 08/1995.

Regarding independent claim 9, the claim incorporates substantially similar subject matter as claims 1 and 6, and is rejected along the same rationale. Chadha teaches a storage unit (Chadha, col.4, lines 22-25). Chadha does not explicitly disclose a document transmitting unit to transmit said document to a network. However, Chadha teaches document, such as HTML embeds dynamic data is sent over a network (Chadha, col.1, lines 11-29).

Popp teaches transmitting web page document to a client via WWW (Popp, page 1, paragraph 13 and page 4, paragraph 54; transmitting a web document to display on client's browser through WWW).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Popp's transmitting feature into Chadha to include a

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document transmitting unit to transmit web page document to a network, since transmitting unit allows the web page document to be sent to clients on the Internet.

Regarding claim 10, which is dependent on claim 9, Chadha and Popp teach the limitations of claim 9 as explained above. Refer to the rationale relied to reject claim 9 the limitations of “a client unit including a displaying unit to receive said the modified document from the network, and to display the modified document on said displaying unit” is included. The rationale is incorporated herein.

Regarding claim 11, which is dependent on claim 9, Chadha and Popp teach the limitations of claim 9 as explained above. Chadha teaches the parameter is received from an application utilizing the document (Chadha, col.5, line 29 – col.6, line 20 and col.6, line 7 – col.7, line 9).

Regarding dependent claim 12, the claims incorporate substantially similar subject matter as claim 2 and is rejected along the same rationale.

Allowable Subject Matter

9. Claims 5, 8 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 07/20/06 have been fully considered but they are not persuasive.

Applicants argue that with respect to independent claims 1, 6 and 9 that, “there is no parameter referred to at all in Chadha, a parameter which specifies an area to be processed, a word line to be replaced in the area, and a word line to be substituted for the replace word line” (Remarks, page 9, paragraph 4).

This is not persuasive. Chadha teaches referring a parameter which specifies an area to be processed, such as the area between begin datatag and end datatag, a word line to be replaced in the are, such as source-string “XXX”, and a target-string “%exec_sql(sql1)” for substituting the source-string (Chadha, col.5, line 60 – col.6, line 5).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Myers et al., US 6,839,881 B2, filed 08/01, teaches limited access network database system.

Hassett et al., US 6,173,311 B1, filed 02/97, teaches method of manufacture for servicing client requests on a network.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V. Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thu V. Huynh
September 30, 2006